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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,171

08/23/2005

Hermann Schennach

72.099

5733

23598

7590

05/09/2007

BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.

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SUITE 1030

MILWAUKEE, WI 53202

EXAMINER

ADDIE, RAYMOND W

ART UNIT

PAPER NUMBER

3671

MAIL DATE

DELIVERY MODE

05/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,171

Applicant(s)

SCHENNACH ET AL.

Examiner

Raymond W. Addie

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12-14 is/are rejected.
- 7) ☒ Claim(s) 5 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.


RAYMOND ADDIE
PRIMARY EXAMINER

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stayner # 6,551,022 B1 Frohnauer, Jr. # 3,232,188.

Stayner discloses a soil compacter (10) comprising:

A lower mass (12), comprising a compacting plate.

An upper mass (20) connected with the lower mass (12) via,

A spring damping device (16).

A vibration generator (22) that oscillates the compacting plate (12).

What Stayner does not disclose is the use of a hand truck or similar transporting means.

Frohnauer teaches a soil compacting device comprising:

However, Frohnauer teaches it is well known to provide soil compactors (20) with a wheeled support frame (22/24) including elements (26, 28, 30, 32). See Col. 1, Ins. 1-5.

The frame supporting a pair of wheels (21), raised above and out of contact with the soil being compacted.

Wherein the machine can be tilted to a transport position, wherein the wheels (21) permit rolling the machine to and from, while the compacting plate, which is attached to the wheels (21), is raised above and out of contact with the soil just compacted.

The provision of the wheels obviating the need for one or more people to lift and carry the machine to a work truck or the like. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the soil compactor of Stayner, with transport wheels, as taught by Frohnauer, in order to save effort and injury to operator of the machine. See Frohnauer Col. 2.

With respect to claims 2-7, 9-14 Fronhauer clearly teaches by illustration that; for the given wheel (21) diameter, the axial position of the wheel axle (unnumbered), is selected such that, in a vibration position, the compacting plate (38) makes flat contact with the soil as at (114), and the wheels (21) are raised above, and out of contact with the soil being compacted. See Figs. 7-10. Fronhauer further teaches the change, from a compacting position, to a transport position is affected by tipping the machine about an axis that corresponds essentially to the wheel axle. Such that, the axial position of the wheel axle and the size of the wheels (21) are adapted to permit; in a vibrating position a distance to exist between the soil contact surface (114) of the plate (38), and the lowest point of the wheels (21), and a distance exists in the transportation position, between the soil compaction plate surface (114) and the soil being transported over. Fronhauer further teaches the upper mass (34) is supported on a step surface (32) that

positions the center of gravity of the machine to facilitate tipping said machine between the vibrating position and the compacting position. See Figs. 7-10; col. 2.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the compacting machine of Stayner, with a wheels assembly, positioned as taught by Fronhauer, to facilitate tipping the machine onto the transport wheels (21) for ease of transport.

2. Claims 1-4, 6-10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stayner # 6,551,022 B1 in view of Brown et al. # 2,856,828.

Stayner discloses a soil compacter (10) comprising:

A lower mass (12), comprising a compacting plate.

An upper mass (20) connected with the lower mass (12) via,

A spring damping device (16).

A vibration generator (22) that oscillates the compacting plate (12).

What Stayner does not disclose is the use of a hand truck or similar transporting means.

However, Brown et al. teaches it is old and well known to mount transport rollers (12) to soil compacting devices (10) in order to tilt the device onto the wheels (12) for transport.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the soil compacting device, of Stayner, with transport wheels, as taught by Brown et al., in order to facilitate transport of the soil compaction device. See Brown et al. Col. 2.

Allowable Subject Matter

3. Claims 5, 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant's arguments filed 3/12/07 have been fully considered but they are not persuasive. Applicant argues against the combination of Stayner in view of Frohnauer by suggesting the combination does not suggest nor teach "the undercarriage axle is stationary in relation to the device".

However, the axle assembly of Frohnauer appears to be fixed relative to the device, and tiltable between a working configuration and a transport configuration.

Applicant then argues "the tamping machine disclosed by Frohnauer is drastically different from that disclosed by Stayner and is technically defective".

However, the Examiner does not concur.

Both devices are disclosed as soil compaction devices having a bottom compaction plate. Hence, it is unclear what Applicant considers to be "drastically different".

Patentability of the claimed invention is dependent upon whether the combined teachings of the prior art teach or otherwise render Applicant's claimed invention

obvious, to the extent, as to whether or not one of ordinary skill in the art, in light of the cited prior art, would find mounting transport wheels to a notoriously heavy and bulky work machine would be well within the skill of one in the art, as taught or reasonably suggested by the prior art. To which it appears obvious, from the teaching of Frohnauer, that transport wheels are advantageous to the use of single operator, walk-behind, compacting machines.

Therefore, the arguments are not persuasive and the rejection is maintained.

Applicant then argues "Figures 7 to 10 of Frohnauer are physically incorrect...the flight phase (Fig. 9) would then be the point at which the weight was at the bottom, not at the top as shown in fig. 9".

It is unclear what if any relevance Applicant's cited statement has to do with the actual claim language. Therefore, the argument appears to lack criticality and is therefore non-persuasive.

Applicant then argues "The depicted machine has either has an insufficient compacting effect (it does not jump, or does so only slightly), or the drive motor destroys itself in a short time".

However, the argument does not appear directed to any actual limitation in the claims, and further appears to be conjecture on Applicant's part.

Therefore, the argument is non-persuasive and the rejection is maintained.

Applicant then argues "The machine....Frohnauer also departs from the....design in failing to decouple the lower mass from the upper mass by springs or the like".

However such is already taught by the primary reference to Stayner. Hence it is unnecessary for a secondary reference to re-teach that which is already disclosed by the primary reference. See Stayner Col. 2, Ins. 20-25.

Applicant then argues "Applicants disagree with the Examiner's assertion that the Frohnauer patent discloses "a pair of wheels (21), raised above and out of contact with the soil being compacted" (Office Action dated 10/11/2006, page 2, end of paragraph 1)." Structure 21 is not described, in any regards, in the text of the Frohnauer patent. Thus, since there is no written portrayal of structure 21, any interpretation of the structure is limited to the drawings. Merely because a structure has a round perimeter, such as that of structure 21, does not make it a suitable load bearing wheel or roller. There is no indication whatsoever that the element 21 alleged by the Examiner is a wheel capable of supporting the load of the machine during transport".

However, Applicant is cordially reminded there is no explicit requirement in a 35 U.S.C. 103(a) rejection for the prior art to "explicitly recite" the claimed limitation.

Rather, a rejection based on obviousness only requires one of ordinary skill in the art, at the time the invention was made, to find the proposed combined teachings of the prior art to reasonably suggest the desired modification. Hence, in the case of Frohnauer, it would be obvious, for one of skill in the art, to consider element (21) to be a load bearing wheel, with or without linguistic verification from the specification of the Frohnauer.

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Applicant's argument that Frohnauer does not disclose or teach a stationary axle, and hence if an axle exists in Frohnauer, it must be movable; is clear conjecture by Applicant and is not supported by the actual reference to Frohnauer.

Therefore the argument is not persuasive and the rejection is maintained.

Applicant then argues "the Examiner erroneously states that Frohnauer teaches that a change may be made from a compacting position to a transport position by tipping the machine about an axis that correspond to essentially of the wheel axis. A review of Frohnauer's admittedly fanciful and inconsistent drawings indicates that any tipping would appear to occur at the rear end of the plate 114, i.e., immediately above the reference numbered 114 in Figures 7-10.

That tipping point is located well in front of the alleged axle of the element 21 alleged by the Examiner to correspond to the claimed wheel".

However, the Examiner does not concur. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Clearly Frohnauer teaches the use of transport wheels for use on soil compactors. It is further, obvious to one of ordinary skill in the art, at the time the invention was made, that when modifying the compactor of Stayner with transport wheels, as taught by Frohnauer, the wheels would be oriented to permit a user to "tip" the device into a transport or operational modes such that "tipping the machine about an axis that correspond to essentially of the wheel axis".

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond W. Addie whose telephone number is 571 272-6986. The examiner can normally be reached on 6AM-2:00PM.

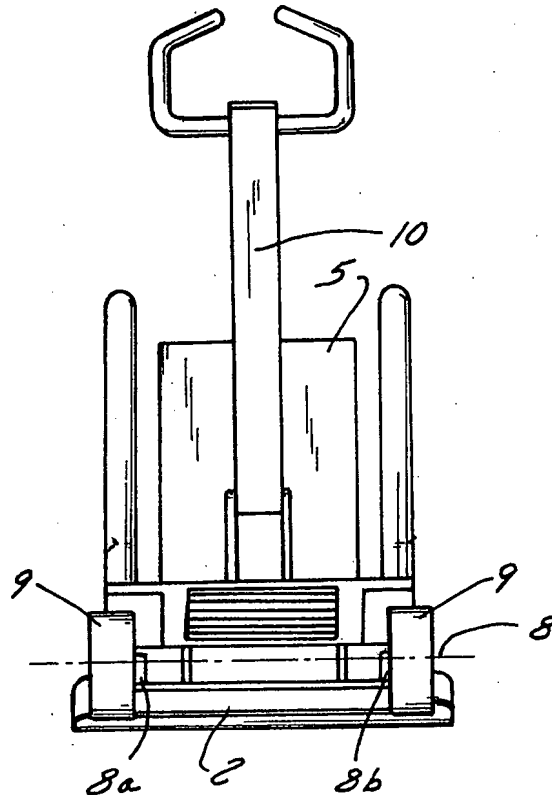
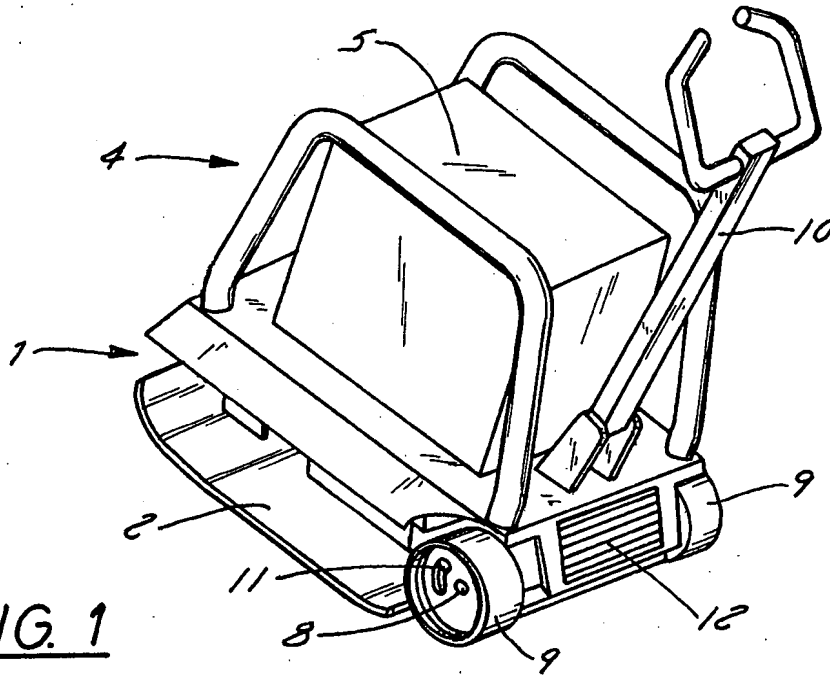
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 571 272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raymond Addie
Primary Examiner
Group 3600

5/8/07



Approved Lut: 5/7/07

FIG. 3

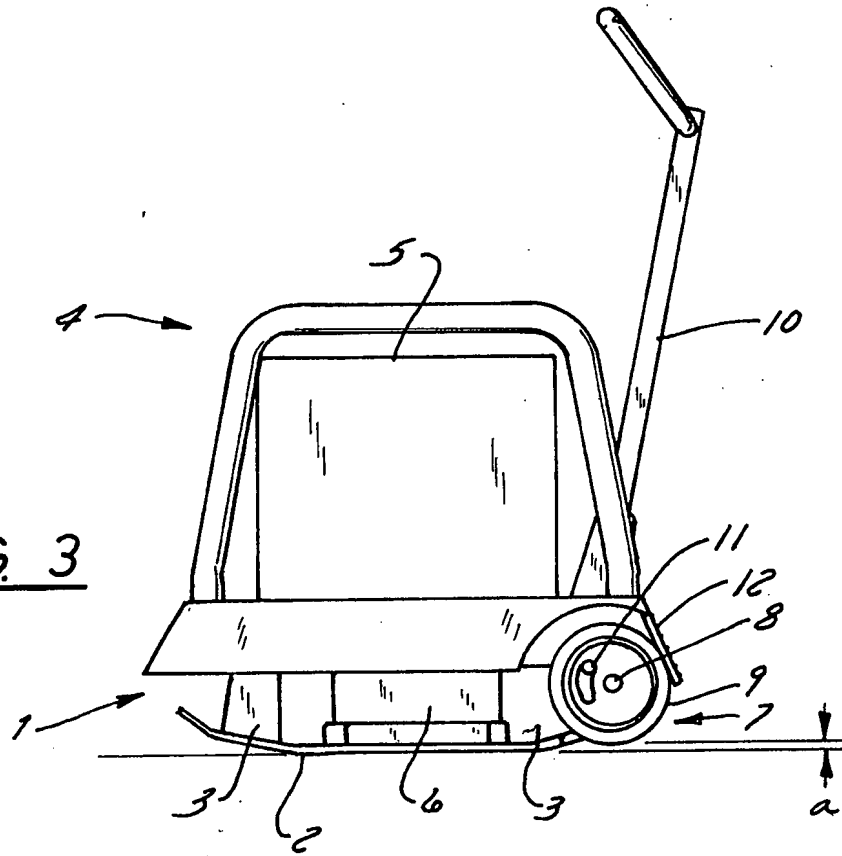
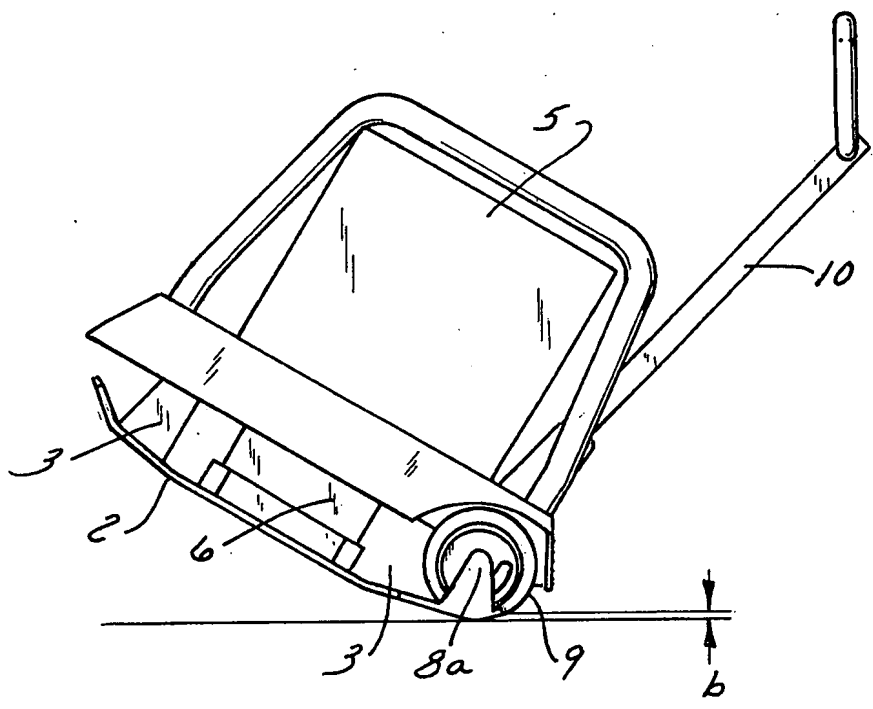


FIG. 4



Approved for 5/7/07